REMARKS

In response to the Office Action dated November 27, 2006, Applicants respectfully request reconsideration based on the above amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1-20 have been rejected. By this amendment, claims 1 and 7 have been amended and claims 2 and 8 have been cancelled. Accordingly, claims 1, 3-7, and 9-20 are pending in the present Application. Claims 1, 3-7, and 9-20 are considered allowable for at least the reasons given below.

Claim Rejections 35 U.S.C. §102(b)

Claims 1-18 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Whalen. U.S. Patent No. 6,243,836 hereinafter referred to as "Whalen".

Applicants respectfully contend that the explanation in the Office Action mischaracterizes the teachings of Whalen. To anticipate a claim under 35 U.S.C. §102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

It is respectfully submitted that Whalen does not contain all elements set forth in Applicants' claims 1 and 7. Specifically, Whalen does not teach or disclose Applicants' claimed feature wherein "upon exiting compression mode, establishing a write address for further trace data such that trace data prior to exiting compression mode is maintained, wherein said establishing said write address includes retrieving a jump-to address outside of said wrap-back address space and writing said further trace data to said jump-to address space."

Referring to the passages cited by the Examiner (Col. 1, lines 5-11; Col. 4,

lines 1-5; Col. 6, lines 44-50; and Col. 7, lines 22-40 of the Whalen reference), Whalen discloses compressing empty trace codes using Huffman-coded length counts. These empty codes are stored in RAM 16. At col. 8, lines 6-12, Whalen states that RAM 16 is managed as a circular buffer of discontinuity codes wherein, when the buffer fills up, the oldest data will be overwritten with new data. This is in complete contrast to Applicants' claimed approach where a write address is established by retrieving a jump-to address outside of said wrap-back address space and writing said further trace data to said jump-to address space. Whalen neither discloses nor suggests use of a jump-to address outside of the wrap-back address space. Rather, Whalen writes all trace data to the circular buffer of RAM 16. Therefore, because Whalen does not disclose or teach the aforementioned elements of Applicants' claimed invention, Whalen cannot anticipate the Applicants' claims. Thus, claims 1 and 7 are allowable, the rejections are improper, and they should be withdrawn.

In view of the above discussion, claims 3-6 depend from claim 1,whether directly or indirectly, and include all of the corresponding limitations thereof. Similarly, claims 9-12 depend from claim 7, whether directly or indirectly, and include all of the corresponding limitations thereof. Since claims 1 and 7 are not taught by Whalen, claims 3-6 and 9-12 cannot be taught by Whalen. Thus, Claims 1, 3-7, and 9-12 are allowable, the rejections are improper and they should be withdrawn.

It is also respectfully submitted that Whalen does not contain all elements set forth in Applicants' claims 13 and 16. Specifically, Whalen does not teach or disclose Applicants' claimed feature for "providing a user programmable sensitivity setting for each unit generating trace data." The passages cited by the Examiner (Col. 5, lines 1-32 and Col. 7, lines 22-40 of the Whalen reference), merely describe a list of trace codes that may be present in a bit stream input. These trace codes refer to instructions that were executed by the processor or instructions which the processor attempted to execute. Whalen neither discloses nor suggests a user programmable sensitivity setting for each unit generating trace data. Therefore, because Whalen does not disclose or teach the aforementioned elements of Applicants' claimed invention, Whalen cannot anticipate the Applicants' claims. Thus, claims 13 and 16 are allowable, the rejections are improper, and they should be withdrawn.

In view of the above discussion, claims 14 and 15 depend from claim

13,whether directly or indirectly, and include all of the corresponding limitations thereof. Similarly, claims 17 and 18 depend from claim 16, whether directly or indirectly, and include all of the corresponding limitations thereof. Since claims 13 and 16 are not taught by Whalen, claims 14, 15, 17, and 18 cannot be taught by Whalen. Thus, Claims 13-18 are allowable, the rejections are improper and they should be withdrawn.

Claim Rejections 35 U.S.C. §102(a)

Claims 19-20 are rejected under 35 U.S.C. §102(a) as being anticipated by Kahle et al. US. Patent 6,543,002, hereinafter referred to as "Kahle".

Applicants respectfully contend that the explanation in the Office Action mischaracterizes the teachings of Kahle. To anticipate a claim under 35 U.S.C. §102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ...claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).

It is respectfully submitted that Kahle does not contain all elements set forth in Applicants' claims 19 and 20. Specifically, Whalen does not teach or disclose Applicants' claimed feature of "initiating a trace capture in response to detecting said pre-hang condition". Referring to the passages cited by the Examiner (Col. 7, lines 1-21), Kahle describes a process whereby a hang detect unit starts counting the number of clock cycles and, after the count equals a predetermined number, a flush signal is initiated. However, Kahle fails to disclose Applicants' claimed initiation of a trace capture in response to detection of a pre-hang condition. Moreover, Applicants conducted a word search of Kahle and failed to locate any occurrence of the term "trace capture". Therefore, because Kahle does not disclose or teach an element of the invention it cannot anticipate the Applicants' claims. Thus, claims 19 and 20 are allowable, the rejections are improper, and they should be withdrawn.

CONCLUSION

The arguments and amendments presented herein are made for the purposes of better defining the invention, rather than to overcome the rejections for patentability. The claims have not been amended to overcome the prior art and therefore, no presumption should attach that either the claims have been narrowed over those earlier presented, or that subject matter or equivalents thereof to which the Applicant is entitled has been surrendered. Allowance of the claims is respectfully requested in view of the above remarks. Moreover, no amendments as presented alter the scope of the claimed invention and therefore cannot necessitate a new grounds rejection.
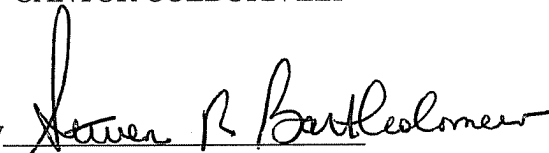
It is believed that the foregoing remarks are fully responsive to the Office Action and that the claims herein should be allowable to the Applicant. In the event the Examiner has any queries regarding the instantly submitted response, the undersigned respectfully request the courtesy of a telephone conference to discuss any matters in need of attention.

If there are any additional charges with respect to this Response or otherwise, please charge them to Deposit Account No. 09-0463.

Respectfully Submitted,

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